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| 09/755,934 | 01/04/2001 | Elliot Cooperstone | 37202/107001; 990015 | 3860 |
| 57956 7590 02/25/2009 OSHA - LIANG L.L.P. (INTUIT) TWO HOUSTON CENTER 909 FANNIN STREET, SUITE 3500 HOUSTON, TX 77010 | | | | |
| EXAMINER | | | | |
| OUELLETTE, JONATHAN P | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3629 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/755,934

Applicant(s)

COOPERSTONE ET AL.

Examiner

Jonathan Ouellette

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 59-103 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 59-103 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date: _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Claims 1-58 and 99 have been cancelled; therefore, Claims 59-98 and 100-103 are currently pending in application 09/755,934.

Drawings

2. The drawings were received on 7/8/2008. These drawings are acceptable.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 59-72 are rejected under 35 U.S.C. 101 because the independent claims fails to meet the machine-or-transformation test, and therefore, fails to satisfy § 101 requirements.**
5. The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See Benson, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, as illustrated by Benson and discussed below, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See Benson, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed

process must not merely be insignificant extra-solution activity (i.e. saving data in a database and displaying data from a database). See Flook, 437 U.S. at 590.

6. Therefore, because the applicable test to determine whether a claim is drawn to a patent-eligible process under § 101 is the machine-or-transformation test set forth by the Supreme Court and clarified herein, and independent Claims 59-72 plainly fail that test, the claims are rejected.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 59-65, 68-70, 73-79, 82-84, 87-89, 92-94, and 97-98 are rejected under 35

U.S.C. 103(a) as being unpatentable over Gupta et al. (US 5,913,061).

9. As per **independent Claims 59, 73, 87, and 97**, Gupta discloses a method (system, apparatus) of integrating a plurality of human resource (HR) services (C9 L32-37, HR use), comprising: receiving a data item associated with a customer (Abstract, trigger); identifying an event from the data item (Abstract, Fig.2, C12-C13); determining a first HR service and second HR service (Application) of the plurality of HR services affected by the event, wherein the customer holds subscriptions to the first HR service and the second HR service, and wherein determining the first HR service and the second HR service is based on the subscriptions (Fig.2, C12-C13, Applications in system indicate Application user is

“subscribed” to); initializing a first update task and a second update task, wherein initializing the first update task and the second update task are triggered by the event; converting the data item to a first format accepted by the first HR service; converting the data item to a second format accepted by the second HR service; executing the first update task to update the first HR service based on the event, wherein executing the first update task comprises sending the data item in the first format to the first HR service; and executing the second update task to update the second HR service based on the event wherein executing the second update task comprises sending the data item in the second format to the second HR service, wherein the first HR service and the second HR service form a portion of an HR management system for the customer (Fig.2, data received, converted into an event – update function initiated for Applications that subscribe to the event; C12-C13).

10. As per Claims 60, 74, and 88, Gupta discloses assigning a first priority to the first update task; and assigning a second priority to the second update task, wherein an order of executing the first update and executing the second update task is based on the first priority and the second priority (C19, Queue Events).
11. As per Claims 61 and 75, Gupta discloses wherein the second priority exceeds the first priority and the second update task is executed before executing the first update task (C12-C13, C19).
12. As per Claims 62 and 76, Gupta discloses wherein the first update and the second update task are executed synchronously (C12-C13, C19).
13. As per Claims 63, 77, and 89, Gupta discloses determining a plurality of critical products including the first HR service and the second HR service; determining a third HR service and

a fourth HR service affected by the event, wherein the third HR service and the fourth HR service are non-critical products; and executing a third update task to update the third HR service and a fourth update task to update the fourth HR service after executing the first update task and the second update task (Abstract, two or more, C12-C13).

14. As per Claims 64 and 78, Gupta discloses wherein the third update task and the fourth update task are executed asynchronously (C12-C13).
15. As per Claims 65 and 79, Gupta discloses sending a request to the customer for additional data item regarding the event; receiving the additional data item; and converting the additional data item to the first format, wherein executing the first update task further comprises sending the additional data item in the first format to the first HR service (C12-C13).
16. As per Claims 68, 82, and 92, Gupta discloses receiving a selection from the client, wherein the selection comprises the first HR service and the second HR service; and installing the first HR service and the second HR service (Fig.2).
17. As per Claims 69, 83, and 93, Gupta discloses installing the first HR service and the second HR service in the HR management system before receiving the data item (Fig.2)
18. As per Claims 70, 84, and 94, Gupta discloses alerting the customer of an outstanding HR function requiring execution after identifying the event (Abstract, System is responsive to trigger).
19. As per Claim 98, Gupta discloses a translation rules repository storing rules for converting the data item (C17, L32-38, Data Transformations).

20. Claims 66, 67, 71, 72, 80, 81, 85, 86, 90, 91, 95, 96, and 100-103 are rejected under 35

U.S.C. 103 as being unpatentable over Gupta.

21. As per Claim 66, 80, 90, and 100, Gupta does not expressly show wherein the event is at least one selected from a group consisting of a change in marital status, a change in health status, a change in retirement status, a change in location, a change in financial compensation, a change in address, a change in dependents of an employee of the customer.
22. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The method (system, apparatus) of integrating a plurality of human resource (HR) services would be performed regardless of the type of event. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
23. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have monitored a variety of events, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.
24. As per Claim 67, 71, 72, 81, 85, 86, 91, 95, 96, and 101-103, Gupta does not expressly show wherein the first HR service is provided by at least one selected from a group consisting of a health insurance provider, disability insurance provider, a life insurance provider, an income tax preparation service, and a payroll service provider.
25. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The method (system, apparatus) of integrating a

plurality of human resource (HR) services would be performed regardless of the type of HR service (Application) utilized. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

26. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a variety of HR Services (Applications), because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Response to Arguments

27. Applicant's arguments filed on 12/5/2008, with respect to Claims 59-103, have been considered but are not persuasive. The rejection will remain as Non-Final, based on the cited prior art.
28. Furthermore, applicant's arguments filed on 12/5/2008, with respect to Claims 59-72, have been considered but are moot, based on the new grounds of rejection (101 rejection).
29. The Applicant's arguments are addressed in the clarified rejection above.

Conclusion

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

31. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.
32. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (571) 272-4000. Information regarding the status of an application may also be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

February 23, 2009

/Jonathan Ouellette/

Primary Examiner, Art Unit 3629